

# Office Action Summary

**Application No.**

09/909,015

**Applicant(s)**

SUGAWARA, KAZUHIRO

**Examiner**

Paul H. Kang

**Art Unit**

2144

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49-50, 52-61 and 63-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49, 50, 52-61 and 63-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: 03/26/2008
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 19, 2007 has been entered.

### ***Status of Claims***

2. Claims 1-48, 51, 62 and 72 are canceled. Claims 49-50, 52-61 and 63-71 are now pending. A detailed action follows.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 49-50, 52-61 and 63-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger et al., US Pat. No. 6,073,142, in view of Aronson et al., US Pat. No. 6,654,787.

5. As to claim 49, Geiger teaches the invention substantially as claimed. Geiger teaches a communication apparatus which is connected to an E-mail server via a network, said communication apparatus comprising (Geiger, Fig 1,102):

a receiving unit (Geiger, Fig 3, 282), adapted to receive an E-mail which is to be sent to said communication apparatus stored in a mailbox provided on an E-mail server (Geiger, Col. 11, lines 1-10);

a first obtaining unit (Geiger, Fig 2, 200), adapted to obtain size information, the size information indicating a size of the E-mail stored in the mailbox (Geiger, Col. 3, lines 40-50, Col. 6, lines 20-25, Col. 6, lines 50-60, Col. 10, lines 30-40);

a discriminating unit (Geiger, Fig 2, 210), adapted to discriminate whether or not to receive the E-mail before said receiving unit receives the E-mail based on the size information obtained by said first obtaining unit (Geiger, Col. 10, lines 32-42; col. 3, lines 29-52, col. 12, lines 32-51, col. 13, lines 15-34);

wherein, in a case where said discriminating unit discriminated to receive the E-mail, said receiving unit receives the E-mail that said discriminating unit discriminated to receive, and in a case where said discriminating unit discriminates not to receive the E-mail, said receiving unit does not receive the E-mail that said discriminating unit has discriminated not to receive (Geiger, Col. 10, lines 32-42, Col. 7, lines 3-15); and

wherein said discriminating unit further discriminates whether or not to receive an E-mail other than the E-mail that said discriminating unit has discriminated not to receive (Geiger, Col 10, lines 32-42).

However, Geiger does not explicitly teach a discriminating unit, adapted to discriminate whether or not to receive the E-mail stored in the mail box before said receiving unit receives the E-mail from the E-mail server by sending a command. In the same field of endeavor, Aronson teaches a system and method for filtering emails comprising a discriminating unit, adapted to discriminate whether or not to receive the E-mail stored in the mail box before said receiving unit receives the E-mail from the E-mail server, based on the attribute information (Aronson, col. 8, lines 3-44, col. 4, line 35 – col. 5, line 19 and col. 5, lines 22-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the email server mailbox filtering as taught by Aronson into the email filtering system of Geiger for the purpose of decreasing network traffic and filter efficiency. Further, applying the known technique of remote filtering as taught by Aronson to the known device of Geiger would yield predictable results.

6. As to claims 50 and 59, Geiger-Aronson teaches the communication apparatus further comprising a controlling unit (Geiger, Fig 2), adapted to, in a case where said discriminating unit discriminated not to receive the Email, send to the E-mail server an instruction for deleting from the mail box the E-mail that said discriminating unit discriminated not to receive, and to delete E-mails after the receiving unit receives that E-mail (Geiger, Fig 4, 422; Col 10, lines 43-62; Col. 7, lines 3-15).

7. As to claim 52, Geiger-Aronson teaches a communication apparatus further comprising a second obtaining unit, adapted to obtain maximum value information of a size of the E-mail

capable of being received by said receiving unit (Geiger, Col 3, lines 28-51), wherein said discriminating unit discriminates whether or not to receive the E-mail by comparing the size information of the E-mail obtained by said first obtaining unit with the maximum value information obtained by said second obtaining unit (Geiger, Col 3, lines 28-51, Col 10, lines 32-42).

8. In claim 53, Geiger-Aronson teaches a communication apparatus wherein said controlling unit receives only header information of the E-mail that said discriminating unit discriminates not to receive, and stores, as communication history information, information obtained from the received header information. Discrimination that is made base on sender is extracted from the source address of the header (Geiger, Fig 14, Col 10, lines 50-55, Col 23, lines 1-5).

9. In claim 54, Geiger-Aronson teaches about a communication apparatus wherein said controlling unit stores as communication history information the size information of the E-mail that said discriminating unit discriminates not to receive (Geiger, Fig 14, Col 10, lines 43-62, Col 23, lines 1-5).

10. In claim 55, Geiger-Aronson teaches about a communication apparatus according to Claim 23, wherein said controlling unit stores as communication history information a fact that the reception by said receiving unit to the E-mail that said discriminating unit discriminates not to receive is stopped (Geiger, Fig 14, Col 10, lines 43-62, Col 23, lines 1-5).

11. In claim 56, Geiger-Aronson teaches about a communication apparatus wherein said controlling unit stores as communication history information a fact that the E-mail that said discriminating unit discriminates not to receive is deleted (Geiger, Fig 14, Col 10, lines 43-62, Col 23, lines 1-5).

12. In claim 57, Geiger-Aronson teaches about a communication apparatus wherein, in a case where said receiving unit receives the E-mail that said discriminating unit discriminates to receive, said controlling unit stores as communication history information the information obtained from the E-mail received by said receiving unit (Geiger, Fig 14, Col 10, lines 43-62, Col 23, lines 1-5).

13. In claim 58, Geiger-Aronson teaches about a communication apparatus further comprising an output unit, adapted to, in a case where said receiving unit receives the E-mail that said discriminating unit discriminates to receive, output the E-mail received by said receiving unit (Geiger, Col 10, lines 43-62).

14. Claims 60-61 and 63-70 are the methods to the apparatus of claims 49-59 respectively, and are rejected under the same rationale as claims 49-59.

15. Claim 71 is the computer-readable medium storing a program applied to the apparatus of claim 49, and is rejected for the same reason as claim 49.

16. In claim 47, Geiger-Aronson teaches about a communication apparatus according to Claim 23, wherein, said controlling unit sends to said E-mail server an instruction for deleting from the mail box the E-mail that said discriminating unit discriminated to receive (i.e. forwarding), after said receiving unit receives the E-mail that said discriminating unit discriminated to receive (Geiger, Col 10, lines 43-62).

17. In claim 48, Geiger-Aronson teaches about a communication method according to Claim 34, wherein, said controlling step includes sending to said E-mail server an instruction for deleting from the mail box the E-mail that said discriminating step discriminated to receive (i.e. forwarding), after the Email that said discriminating unit discriminated to receive is received in said receiving step (Geiger, Col 10, lines 43-62).

### ***Response to Arguments***

18. Applicant's arguments with respect to claims 49-50, 52-61 and 63-71 have been considered but are moot in view of the new ground(s) of rejection. Applicants argued in substance that the prior art does not teach or suggest discriminating whether or not to receive E-mail based on the size information of the E-mail. See Remarks, page 12, lines 18-23, page 13, lines 1-13 and page 13, line 20 - page 14, line 6. The new grounds of rejection teaches this feature.

In addition to the newly added limitations, Applicant further argues the "Rule Enforcing Post Office 102" of Geiger does not correspond to the "communication apparatus" of the present

invention as the communication apparatus as claimed is the intended destination of the E-mail. Applicants further argue that the prior art performs “email filtering based on information of an email only after receiving the email from an email server.” See Remarks, page 13, lines 14-19. These arguments are not deemed to be persuasive

Geiger was cited to each and every limitation of the invention (exemplary claim 49) except for discriminating whether or not to receive the email stored in the mail box before said receiving unit receives the email from the email server. Aronson was relied upon to teach this limitation. Aronson allows a user device to control email discrimination prior to receiving the email from the email server (Aronson, col. 8, lines 2-44). Therefore, the “communication apparatus” of claim 49, when interpreted without the limitation “adapted to discriminate whether or not to receive the email stored in the mail box before said receiving unit receives the email from the email server,” is taught by the Rule Enforcing Post Office 102 of Geiger. Accordingly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H. Kang/  
Primary Examiner  
Art Unit 2144